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**OCT 12 2007**

**OFFICE OF PETITIONS**

LOCKE LORD BISSELL & LIDDELL LLP  
2200 ROSS AVENUE  
SUITE 2200  
DALLAS, TX 75201-6776

In re Application of Muncaster and Millican :  
Application No. 10/784,410 :  
Filing Date: February 23, 2004 :  
Attorney Docket No. 72531 00001 :

Decision on Petition

This is a decision on the petition filed June 13, 2007, under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application. Attorney Jack Kanz signed and filed the petition.

The petition is **dismissed**.

Facts:

An executed declaration was filed with the application on February 23, 2004. The declaration stated all correspondence should be sent to the address associated with Customer No. 20873.

A "Revocation of Power of Attorney With New Power of Attorney And Change of Correspondence" (Power of Attorney) form was filed August 12, 2005. The Power of Attorney sought to have the practitioners associated with Customer No. 41254 become the new representatives of record. The Power of Attorney sought to have the address or record changed to the address associated with Customer No. 41254.

The Power of Attorney was signed by inventor Muncaster, but not by inventor Millican. The Power of Attorney indicated Muncaster was an inventor. The paper did not indicate Muncaster was the assignee, signing on behalf of an assignee, or include a statement under 37 CFR 3.73(b).

On August 26, 2005, the Office mailed a Notice stating the August 12, 2005 paper lacked the signature of inventor Millican. The Office stated the Power of Attorney would, "be entered upon receipt of confirmation signed by said co-inventor."

A response to the August 26, 2005 Notice was filed September 2, 2005. The response did not include a Power of Attorney signed by inventor Millican.

The September 2, 2005 response stated,

The signature of Tony Joe Millican, a co-inventor in this application, was not omitted. The Power of Attorney was signed by the Assignee.

The September 2, 2005 response did not include a statement under 37 CFR 3.37(b) to establish inventor Muncaster was the assignee.

The Power of Attorney was not entered. The Office did not mail any form of notice stating the Power of Attorney had been entered.

The only correspondence address of record was the address associated with Customer Number 20873. Therefore, when the Office later received status inquiries, the Office properly responded by sending correspondence to the address of record.

On May 22, 2006, the Office mailed a non-final Office action including a requirement for restriction/election to the address of record (Customer No. 20873).

By unknown means, Attorney Jack Kanz, who filed the instant petition, obtained a copy of the non-final Office action. Attorney Kanz filed a reply and a request for an extension of time on July 31, 2006.

On September 22, 2006, the Office mailed a non-final Office action to the address of record (Customer No. 20873). The Office action set a shortened statutory period for reply of three (3) months.

The Office did not receive a response to the September 22, 2006 Office action, or receive a request for an extension of time. As a result, the above-identified application became abandoned on December 23, 2006.

During a telephone conversation with the examiner on June 4, 2007, Attorney Jack Kanz learned the application had become abandoned.

The instant petition was filed on June 13, 2007.

#### Discussion:

In order for the petition to withdraw the holding of abandonment to be granted, petitioner must prove the Office mailed the Notice to an incorrect address or the correspondence was not received at the address of record.

Petitioner has not demonstrated the Office mailed the September 22, 2006 Office action to an incorrect address. Compliance with 37 CFR 3.73(b) required more than a statement that Muncaster was the assignee. The September 2, 2005 paper was not accompanied by any proof Mullican had assigned his entire ownership interest to Muncaster.

Petitioner has not proven, it is more likely than not, the non-final Office action was lost by the USPS and never delivered to the address of record. Although petitioner has supplied evidence to prove the non-final Office action was not received at the address associated with Customer No. 41254, petitioner has failed to supply any showing to establish the non-final Office action was never received at the address of record.

For the reasons above, the Office will not withdraw the holding of abandonment.

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply to the outstanding Office action, the required petition fee (\$750 for a small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form is enclosed for petitioner's convenience.

While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

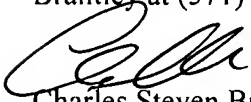
Any request for reconsideration under 37 CFR 1.181 must be submitted within TWO (2) MONTHS from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

Further correspondence with respect to this matter should be addressed as follows:

By mail:        Mail Stop Petition  
                 Commissioner for Patents  
                 P.O. Box 1450  
                 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300  
                 Attn: Office of Petitions

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

  
Charles Steven Brantley  
Senior Petitions Attorney  
Office of Petitions

cc:        Jack Kanz  
            502 So. Cottonwood Drive  
            Richardson, TX 75080

Attachments: Copy of non-final Office action and other papers mailed September 22, 2006  
                 Form PTO/SB/64 (Petition under 37 CFR 1.137(b))  
                 Form PTO/SB/82 (Revocation/Power of Atty/Change of Address form)  
                 Form PTO/SB/96 (Statement under 37 CFR 3.73(b))  
                 Privacy Act Notice



# UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,410	02/23/2004	John W. Muncaster	72531 00001	1795

20873 7590 09/22/2006  
LOCKE LIDDELL & SAPP LLP  
ATTN: STACIE COX  
2200 ROSS AVENUE  
SUITE 2200  
DALLAS, TX 75201-6776

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/784,410

Applicant(s)

MUNCASTER ET AL.

Examiner

Patricia L. Nordmeyer

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) 44-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/04, 6/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of group I, claims 1 - 43 in the reply filed on July 31, 2006 is acknowledged.

### *Information Disclosure Statement*

2. The information disclosure statements (IDS) submitted on February 23, 2004 and June 14, 2004 is being considered by the examiner.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 – 7, 25 – 31 and 41 – 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Tajima et al. (USPN 3,937,640).

Tajima et al. disclose a layered composite waterproofing membrane (Column 15, lines 31 – 33) comprising a layer of rubberized asphalt having first and second sides (Figure 1C, #20; Column 6, lines 6 – 8) with a flexible layer of durable plastic film continuously bonded to the first side (Figure 1C, #14; Column 6, line 63 to Column 7, line 11) and a layer of geotextile

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continuously bonded to the second side (Figure 1C, #6; Column 5, lines 39 – 49) as in claim 1.

The rubberized asphalt is rubber-modified bitumen (Column 6, lines 5 – 8) comprising from about 5 to about 20 or 10 to about 15 percent rubber (Column 6, lines 31 – 45) as in claims 2 – 4.

As in claims 5 – 7, the rubberized asphalt is modified with a block copolymer chosen from styrene-butadiene-styrene block copolymer (Column 6, line 15) or styrene-isoprene-styrene block copolymer (Column 6, line 17). Tajima et al. also disclose a layered composite waterproofing membrane (Column 15, lines 31 – 33) having an overall thickness (Figure 1C) and comprising a layer of rubberized asphalt having first and second sides (Figure 1C, #20; Column 6, lines 6 – 8) with a flexible layer of durable plastic film continuously bonded to the first side (Figure 1C, #6; Column 5, lines 56 – 58) and a release liner releasably attached to the second side (Figure 1C, #14; Column 6, line 63 to Column 7, line 11), the plastic film layer having a thickness comprising about  $\frac{1}{4}$  to about  $\frac{1}{3}$  of the overall thickness of the membrane (Figure 1C, #6) as in claim 25. The rubberized asphalt is rubber-modified bitumen (Column 6, lines 5 – 8) comprising from about 5 to about 20 or 10 to about 15 percent rubber (Column 6, lines 31 – 45) as in claims 26 – 28. As in claims 29 – 31, the rubberized asphalt is modified with a block copolymer chosen from styrene-butadiene-styrene block copolymer (Column 6, line 15) or styrene-isoprene-styrene block copolymer (Column 6, line 17). With regard to claims 41 – 43, the release liner comprises a polymeric film (Column 7, line 3), a paper (Column 7, line 4) or is precoated with a release agent (Column 7, lines 5 – 12).

5. Claims 1 – 4, 8 – 12, 23 – 28, 33 and 39 – 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Stierli (USPN 4,442,148).

Stierli discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 – 57; Figure 1, #3) and a layer of geotextile continuously bonded to the second side (Column 3, lines 42 – 45) as in claim 1. The rubberized asphalt is rubber-modified bitumen comprising from about 5 to about 20 or 10 to about 15 percent rubber (Column 3, lines 9 – 15) as in claims 2 – 4. As in claims 8 and 9, the plastic film has a thickness ranging from about 1 mil up to a thickness where the layer ceases to be flexible (Column 3, lines 58 – 61), and the plastic is cross-laminated to resist punctures (Column 3, line 66 to Column 4, line 1). With regard to claims 10 and 11, the plastic film layer has a thickness ranging from about 10 to about 25 mils or about 20 mils (Column 3, lines 58 – 61). The plastic film layer comprises polyethylene (Column 3, line 67) as in claim 12. Regarding claims 23 and 24, the membrane has an overall thickness ranging from about 30 to about 150 mils or about 65 to about 95 mils (Column 3, lines 35 – 38; Column 3, lines 58 – 61). Stierli also discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) having an overall thickness and comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 – 57; Figure 1, #3) and a release liner releasably attached to the second side (Column 4, lines 28 – 33; Figure 1, #4), the plastic film layer having a thickness comprising about  $\frac{1}{4}$  to about  $\frac{1}{3}$  of the overall thickness of the membrane (Column 3, lines 58 – 61) as in claim 25. The rubberized asphalt is rubber-modified bitumen comprising from about 5 to about 20 or 10 to about 15 percent rubber (Column 3, lines 9 – 15) as in claims 26 – 28. The plastic film layer



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comprises polyethylene (Column 3, line 67) as in claim 34. Regarding claims 39 and 40, the membrane has an overall thickness ranging from about 30 to about 150 mils or about 65 to about 95 mils (Column 3, lines 35 – 38; Column 3, lines 58 – 61). With regard to claims 41 - 43, the release liner comprises a polymeric film, a paper or is precoated with a release agent (Column 4, lines 28 – 33; Figure 1, #4).

*Claim Rejections - 35 USC §103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stierli (USPN 4,442,148) in view of Draper et al. (USPN 3,474,625).

Stierli discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 – 57; Figure 1, #3) and a layer of geotextile continuously bonded to the second side (Column 3, lines 42 – 45). Stierli also discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) having an overall thickness and comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 –

57; Figure 1, #3) and a release liner releasably attached to the second side (Column 4, lines 28 – 33; Figure 1, #4), the plastic film layer having a thickness comprising about  $\frac{1}{4}$  to about  $\frac{1}{3}$  of the overall thickness of the membrane (Column 3, lines 58 – 61). However, Stierli fails to disclose the plastic film layer comprising polypropylene.

Draper et al. teach a laminate of asphaltic material and a film of a polypropylene (Column 6, lines 42 – 43) for the purpose of preventing reflection cracking of a surface that is being used to repair a surface or roadway (Column 2, lines 60 – 63).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the polypropylene film material in Stierli in order to prevent reflection cracking of a surface that is being used to repair a surface or roadway as taught by Draper et al.

8. Claims 14 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stierli (USPN 4,442,148) in view of Clapperton (USPN 4,386,981).

Stierli discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 – 57; Figure 1, #3) and a layer of geotextile continuously bonded to the second side (Column 3, lines 42 – 45). Stierli also discloses a layered composite waterproofing

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membrane (Column 1, lines 5 – 7) having an overall thickness and comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 – 57; Figure 1, #3) and a release liner releasably attached to the second side (Column 4, lines 28 – 33; Figure 1, #4), the plastic film layer having a thickness comprising about  $\frac{1}{4}$  to about  $\frac{1}{3}$  of the overall thickness of the membrane (Column 3, lines 58 – 61). However, Stierli fails to disclose the plastic film layer comprising high-density polyethylene.

Clapperton teaches a laminate of asphaltic material and a film high-density polyethylene (Column 5, lines 1 – 17) for the purpose of preventing moisture vapor transmission through the laminate (Column 2, lines 60 – 63).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the polypropylene film material in Stierli in order to prevent moisture vapor transmission through the laminate as taught by Clapperton.

9. Claims 15 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stierli (USPN 4,442,148) in view of Dempsey et al. (USPN 5,513,925).

Stierli discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side

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(Column 2, lines 55 – 57; Figure 1, #3) and a layer of geotextile continuously bonded to the second side (Column 3, lines 42 – 45). Stierli also discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) having an overall thickness and comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 – 57; Figure 1, #3) and a release liner releasably attached to the second side (Column 4, lines 28 – 33; Figure 1, #4), the plastic film layer having a thickness comprising about  $\frac{1}{4}$  to about  $\frac{1}{3}$  of the overall thickness of the membrane (Column 3, lines 58 – 61). However, Stierli fails to disclose the geotextile being non-woven, made of fibers comprising olefinic polymers, poly-alpha olefins and polyesters or polypropylene.

Dempsey teaches a geotextile being non-woven (Column 6, lines 34 – 35), made of fibers comprising olefinic polymers, poly-alpha olefins and polyesters or polypropylene (Column 3, lines 1 – 16) for the purpose of having a material that allows horizontal movement in an underlying surface to which it is attached without breaking the bond with the underlying pavement (Column 2, lines 58 – 61).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the geotextile being non-woven, made of fibers comprising olefinic polymers, poly-alpha olefins and polyesters or polypropylene in Stierli in order to have a material that allows horizontal movement in an underlying surface to which it is attached without breaking the bond with the underlying pavement as taught by Dempsey.

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10. Claims 20 – 22 and 36 – 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stierli (USPN 4,442,148) in view of Bohnhoff (USPN 5,250,340).

Stierli discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 – 57; Figure 1, #3) and a layer of geotextile continuously bonded to the second side (Column 3, lines 42 – 45). Stierli also discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) having an overall thickness and comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 – 57; Figure 1, #3) and a release liner releasably attached to the second side (Column 4, lines 28 – 33; Figure 1, #4), the plastic film layer having a thickness comprising about  $\frac{1}{4}$  to about  $\frac{1}{3}$  of the overall thickness of the membrane (Column 3, lines 58 – 61). However, Stierli fails to disclose a drainage mat attached to the high-density polyethylene layer by bonding through adhesive.

Bohnhoff teaches a drainage mat (Figure 7) attached to the high-density polyethylene layer (Column 1, lines 57 – 60) by bonding through adhesive (Column 4, lines 51 – 55) for the purpose of providing a stabilized surface for vehicular or pedestrian traffic (Column 4, lines 63 – 66).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the drainage mat attached to the high density polyethylene layer by bonding through adhesive in Stierli in order to provide a stabilized surface for vehicular or pedestrian traffic as taught by Bohnhoff.

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stierli (USPN 4,442,148) in view of Terry et al. (USPN 5,763,036).

Stierli discloses a layered composite waterproofing membrane (Column 1, lines 5 – 7) having an overall thickness and comprising a layer of rubberized asphalt having first and second sides (Figure 1, #1; Column 2, lines 51 – 55) with a flexible layer of durable plastic film continuously bonded to the first side (Column 2, lines 55 – 57; Figure 1, #3) and a release liner releasably attached to the second side (Column 4, lines 28 – 33; Figure 1, #4), the plastic film layer having a thickness comprising about 1/4 to about 1/3 of the overall thickness of the membrane (Column 3, lines 58 – 61). However, Stierli fails to disclose a release liner with a thickness ranging up to about 4 mils.

Terry et al. teach a release liner with a thickness ranging up to about 4 mils (Column 4, lines 47 – 47) as part of moisture barrier (Column 8, lines 36 – 37) for the purpose of protecting the tacky surface of the bitumen prior to use (Column 4, lines 55 – 58).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the release liner with a thickness ranging up to about 4 mils in Stierli in order to protect the tacky surface of the bitumen prior to use as taught by Terry et al.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,143,766 to Wenz et al. is cited to show the state of the art with regard to the use of a bituminous sealing web using a non-woven material in combination with a thermoplastic polymer layer.

U.S. Patent No. 5,132,183 to Gaidis et al. is cited to show the state of the art with regard to the use of a waterproof laminate using SBR or SBS in combination with an asphalt.

U.S. Patent No. 5,096,759 to Simpson et al. is cited to show the state of the art with regard to the use of a bituminous sealing web in combination with a thermoplastic polymer layer and a release paper.

U.S. Patent No. 4,684,288 to Chapa is cited to show the state of the art with regard to the use of a pavement tile, which uses a thermoplastic polymer layer in combination with a asphalt aggregate material.


U.S. Patent No. 4,775,567 to Harkness is cited to show the state of the art with regard to the use of a bituminous sealing web in combination with a thermoplastic polymer layer and a release paper

U.S. Patent Application Publication 2001/0002497 to Scuero is cited to show the state of the art with regard to the use of geocomposites in road and bridge construction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

pln



PTO/SB/08- (08-03)

Approved for use through 07/31/2008, OMB 0851-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/PTO

**Complete if Known**

Application Number	10/784,410
Filing Date	February 23, 2004
First Named Inventor	John W. Muncaster
Art Unit	1772
Examiner Name	P. Nordmeyer
Attorney Docket Number	72531 00001

(Use as many sheets as necessary)

Sheet	1	of	1
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## U. S. PATENT DOCUMENTS

[illegible]

## FOREIGN PATENT DOCUMENTS

[illegible]

Examiner Signature	/Patricia Nordmeyer/	Date Considered	09/13/2006
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**EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kind's Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

***If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.***



PTO/SB/08A (08-03)

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U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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Substitute for form 1449/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Sheet 1 of 3

**Complete if Known**

Application Number	10/784410
Filing Date	02/23/2004
First Named Inventor	Muncaster, John W.
Art Unit	3607 1772
Examiner Name	P. Nordmeyer
Attorney Docket Number	72531/00001

U. S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
		US 5,389,166	02/14/1995	White	
		US 6,610,330	02/11/2003	White	
		US-			
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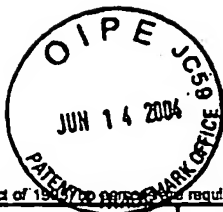
FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T <sup>4</sup>
		Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)	MM-DD-YYYY			

Examiner Signature	/Patricia Nordmeyer/	Date Considered	09/13/2006
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 801.04. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.18 if possible. <sup>6</sup>Applicant is to place a check mark here if English language translation is attached.

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PTO/SB/088 (08-03)

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**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

**Complete if Known**

Application Number	10/784410
Filing Date	02/23/2004
First Named Inventor	Muncaster, John W.
Art Unit	<del>3097</del> 1772
Examiner Name	P. Nordmeyer
Attorney Docket Number	72531/00001

Sheet 2 of 3

**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
PN		GRACE CONSTRUCTION PRODUCTS, Structural Waterproofing - Detail Drawings, 10/30/2003, at: <a href="http://www.na.graceconstruction.com/template.cfm?page=/waterproofing/dd_bit201.html">www.na.graceconstruction.com/template.cfm?page=/waterproofing/dd_bit201.html</a> .	
		GRACE CONSTRUCTION PRODUCTS, Structural Waterproofing - Detail Drawings, 10/30/2003, at: <a href="http://www.na.graceconstruction.com/template.cfm?page=/waterproofing/dd_bit202.html">www.na.graceconstruction.com/template.cfm?page=/waterproofing/dd_bit202.html</a>	
		GRACE CONSTRUCTION PRODUCTS, Structural Waterproofing - Detail Drawings, 10/30/2003, at: <a href="http://www.na.graceconstruction.com/template.cfm?page=/waterproofing/dd_pre209.html">www.na.graceconstruction.com/template.cfm?page=/waterproofing/dd_pre209.html</a>	
		CONSTRUCTION SPECIFICATIONS INSTITUTE, SpecData 2000, Grace Construction Products PrePrufe Waterproofing Systems, Section 07130, circa 2000, USA	
		PARBURY TECHNOLOGIES, Waterproofing Products Products Index, 10/28/2003, at: <a href="http://www.partech.com.au/wprofdes.htm">www.partech.com.au/wprofdes.htm</a>	
		MARKHAM CULVERTS LTD., Geotextiles, 10/28/2003, at: <a href="http://www.markham.com.pg/Culverts/geotex.htm">www.markham.com.pg/Culverts/geotex.htm</a> .	
		GEOSYNTHETICS, INC., Geomembranes, 10/28/2003, at: <a href="http://www.geo-synthetics.com/geomembranes.htm">www.geo-synthetics.com/geomembranes.htm</a> .	
		ADVANCED DRAINAGE SYSTEMS, INC., Geosynthetic Products, circa 1998, USA.	
		PARCHEM CONSTRUCTION PRODUCTS PTY, LTD., Index Preformed Membranes, Argo P, circa 2001, USA.	
PN		PARCHEM CONSTRUCTION PRODUCTS PTY, LTD., Index Preformed Membranes, Elastocene, circa 1999, USA.	

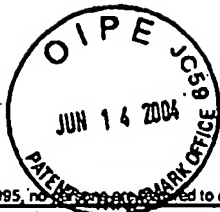
Examiner Signature	/Patricia Nordmeyer/	Date Considered	09/13/2006
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

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PTO/SB/08B (08-03)

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Substitute for form 1449/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

**Complete if Known**

Application Number	10/784410
Filing Date	02/23/2004
First Named Inventor	Muncaster, John W.
Art Unit	<del>3897</del> 1772
Examiner Name	P. Nordmeyer
Attorney Docket Number	72531/00001

Sheet 3 of 3

**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
PN		PARCHEM CONSTRUCTION PRODUCTS PTY, LTD., Index Preformed Membranes, Fidia, circa 1999, USA.	
		PARCHEM CONSTRUCTION PRODUCTS PTY, LTD., Index Preformed Membranes, Testudo, circa 2002, USA.	
		NUPLEX BUILDING PRODUCTS, Bituthene, 10/28/2003, at: <a href="http://www.nuplexbuilding.co.nz/bituthbr.htm">www.nuplexbuilding.co.nz/bituthbr.htm</a> .	
PN		POLYGUARD PRODUCTS, INC., PolyGuard Drainage Mats, 07/19/2000, USA.	

Examiner Signature	/Patricia Nordmeyer/	Date Considered	09/13/2006
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

<b>Notice of References Cited</b>	Application/Control No. 10/784,410	Applicant(s)/Patent Under Reexamination MUNCASTER ET AL.	
	Examiner Patricia L. Nordmeyer	Art Unit 1772	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-3,474,625	10-1969	BENNETT RICHARD J; et. al.	405/270
*	B	US-3,937,640	02-1976	Tajima et al.	156/71
*	C	US-4,386,981	06-1983	Clapperton, Allan S.	156/71
*	D	US-4,442,148	04-1984	Stierli, Robert F.	428/40.3
*	E	US-4,684,288	08-1987	Chapa, Xavier	404/35
*	F	US-4,775,567	10-1988	Harkness, Alex W.	428/40.3
*	G	US-5,096,759	03-1992	Simpson et al.	428/40.3
*	H	US-5,132,183	07-1992	Gaidis et al.	428/489
*	I	US-5,143,766	09-1992	Wenz et al.	428/40.3
*	J	US-5,250,340	10-1993	Bohnhoff, William W.	428/99
*	K	US-5,513,925	05-1996	Dempsey et al.	404/17
*	L	US-5,763,036	06-1998	Terry et al.	428/40.1
*	M	US-2001/0002497	06-2001	SCUERO, ALBERTO M.	14/73

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

First named inventor:

Application No.:

Art Unit:

Filed:

Examiner:

Title:

Attention: Office of Petitions

**Mail Stop Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

**1. Petition fee**

☐ Small entity-fee \$ \_\_\_\_\_ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$ \_\_\_\_\_ (37 CFR 1.17(m))

**2. Reply and/or fee**

A. The reply and/or fee to the above-noted Office action in the form of \_\_\_\_\_ (identify type of reply):

- ☐ has been filed previously on \_\_\_\_\_.
- ☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ \_\_\_\_\_.

- ☐ has been paid previously on \_\_\_\_\_.
- ☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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### 3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

### WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Date

\_\_\_\_\_  
Typed or printed name

\_\_\_\_\_  
Registration Number, if applicable

\_\_\_\_\_  
Address

\_\_\_\_\_  
Telephone Number

\_\_\_\_\_  
Address

Enclosures: ☐ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☐ Other: \_\_\_\_\_

### CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

\_\_\_\_\_  
Date

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Typed or printed name of person signing certificate

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REVOCATION OF POWER OF  
ATTORNEY WITH  
NEW POWER OF ATTORNEY  
AND  
CHANGE OF CORRESPONDENCE ADDRESS**

Application Number

Filing Date

First Named Inventor

Art Unit

Examiner Name

Attorney Docket Number

**I hereby revoke all previous powers of attorney given in the above-identified application.**

☐ A Power of Attorney is submitted herewith.

**OR**

☐ I hereby appoint the practitioners associated with the Customer Number:

☐ Please change the correspondence address for the above-identified application to:

☐ The address associated with  
Customer Number:

**OR**

☐ Firm or  
Individual Name

Address

City

State

Zip

Country

Telephone

Email

I am the:

☐ Applicant/Inventor.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.  
*Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)*

**SIGNATURE of Applicant or Assignee of Record**

Signature

Name

Date

Telephone

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: \_\_\_\_\_

Application No./Patent No.: \_\_\_\_\_ Filed/Issue Date: \_\_\_\_\_

Entitled: \_\_\_\_\_

\_\_\_\_\_, a \_\_\_\_\_  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☐ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest  
(The extent (by percentage) of its ownership interest is \_\_\_\_\_ %)

in the patent application/patent identified above by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.☐ As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

\_\_\_\_\_  
Signature\_\_\_\_\_  
Date\_\_\_\_\_  
Printed or Typed Name\_\_\_\_\_  
Telephone Number\_\_\_\_\_  
Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.